

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested. Claims 2 and 12 have been amended, no claims have been cancelled, and claims 2-21 are currently pending in the present application.

I. 35 U.S.C. § 103(a)

The Office Action rejected independent claims 2 and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Matthews*, in view of *Sutcliffe*, and in further view of *Hockey*. Applicant respectfully traverses the assertion that claims 2 and 12 are obvious in view of *Matthews*, *Sutcliffe*, and *Hockey*.

In general, claims 2 and 12 are directed to an apparatus and a method, respectively, for facilitating electronic collaboration in an environment having a plurality of communities, each of which has a plurality of users. Claims 2 and 12 require "a flagging filter that flags communications between the plurality of live users based on an analysis of at least a textual portion of said communications according to predetermined criteria established by a monitor, wherein the flagging filter is configured to flag communications for review prior to release to their intended recipient."

While *Matthews* states that a group administrator may also have the authority to monitor interaction on message boards and/or to remove inappropriate content, *Matthews* does not disclose, suggest, or teach a system or method wherein a flagging filter flags communications between users based on a textual portion of the

communications according to predetermined criteria established by a monitor prior to release to their intended recipient.

The Office Action states that *Hockey* fills the deficiencies of *Matthews* by disclosing a system wherein messages may be flagged according to certain thresholds and attributes. *Hockey* discloses a system that changes a message's attributes so that it may not be delivered or opened, and/or may be placed in a quarantine zone for review by a system administrator. This is accomplished, however, based on a review of a numerical digest associated with each communication; not on the textual portion of the communication.

The claim limitation set forth above, however, is not obvious in light of *Matthews* in view of *Hockey* because one of ordinary skill in the art could not and would not combine the elements of *Matthews* and *Hockey* in order to perform the function of the claimed limitation. As stated by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007):

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovative the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

Id. at 1741.

Hockey discloses a method for monitoring mail messages particularly for virus attacks and unsolicited commercial email ("spam"). See *Hockey*, abstract. The system described by *Hockey* attempts to accomplish this purpose by generating a numerical representation (a "digest") for the combined subject line and message content (*Hockey*, ¶ 96) and comparing the resulting digest with existing digests stored in memory (*Hockey*, ¶ 102). The *Hockey* system creates and compares the mathematical digest from an electronic mail message ("email") with other stored digests because analyzing the textual content of the email would fail to prevent dissemination of certain viruses and spam – which is the specific purpose of the *Hockey* system. Viruses, such as email worms, and spam generally do not contain content that would be deemed inappropriate by a monitor or filter. It is important to note (as it is expressly noted in *Hockey*) that email worms generally contain malicious code (which would be undetectable to a monitor analyzing textual content), but otherwise "comprise a suitably benign message as further means of deception to the recipients." *Hockey*, ¶ 6 (emphasis added). Thus, the ability to monitor and/or remove inappropriate content based on textual content as described in *Matthews* would have no effect on identifying the emails that the *Hockey* system attempts to prevent. That is, *Hockey* states that monitoring the textual content of certain emails that contain viruses or spam would be useless with respect to the purpose of the *Hockey* system. See *Hockey*, ¶¶ 5-12. In fact, *Hockey* both distinguishes and teaches away from systems wherein communications are filtered based on character strings that the recipient desires not to receive. *Hockey*, paragraph

11. That is, *Hockey* specifically distinguishes systems, such as the one described in *Matthews* and the claimed invention, on the basis that monitoring textual content is ineffective to protect against spam and virus attacks, such as email worms.

Likewise, attempting to modify the system disclosed in *Matthews* with the system set forth in *Hockey* would cause the *Matthews* system to fail for its intended purpose. That is, reviewing messages based on a numerical digest would have no effect on attempting to prevent delivery of communications containing inappropriate content. This is a classic example of teaching away – when the systems of both references would fail for their intended purposes if combined to render the claimed invention. Accordingly, one of ordinary skill in the art would not (and could not) combine elements of the systems disclosed in *Hockey* and *Matthews* to provide the claimed invention.

Additionally, independent claims 2 and 12 require the predetermined criteria used to analyze the relevant communications be established by a monitor. This claim limitation requires the criteria be (1) predetermined and (2) established by a monitor. As noted above and in the Office Action, *Matthews* fails to expressly disclose a second filter that monitors communications between a plurality of live users. *Matthews*, therefore, does not disclose, teach, or suggest filtering based on predetermined criteria established by a monitor.

As explained above, *Hockey* generates a numerical digest for a communication and compares it to the numerical digest of communications that are known to be spam, viruses, or worms. These numerical digests are created based on the combined subject

line and message content so that each communication is associated with a specific numerical digest. Nothing in *Hockey* discloses, teaches, or suggests analyzing the communications based on criteria established by a monitor.

II. Conclusion

Thus, combining the ability to monitor and/or remove inappropriate content described in *Matthews* with the quarantining of messages based on comparison of a numerical digest of the message with other stored numerical digests described in *Hockey* would: (1) render the filtering system disclosed by *Hockey* inoperable and useless for its intended purpose, and (2) would fail to flag any messages based on inappropriate content for the purpose described in *Matthews*. A system that combines elements of the *Matthews* system and the *Hockey* system described above would result in a system that would fail for both the purpose of the *Matthews* system and the purpose of the *Hockey* system. Thus, there is no "reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does." See KSR, 127 S. Ct. at 1741. Importantly, *Hockey* distinguishes and teaches away from monitoring and/or removing messages based on content, which is the portion of *Matthews* the Office Action seeks to combine with *Hockey*.

Since *Hockey* teaches away from *Matthews*, there is nothing to prompt a person of ordinary skill to combine the elements found in *Hockey* and *Matthews*. Importantly, combining the relevant elements of *Hockey* and *Matthews* would defeat the purposes of both *Hockey* and *Matthews* and render the combined system inoperable. Thus, the

present limitation is not obvious in light of *Matthews* in view of *Hockey*. Accordingly, the combination of *Hockey* and *Matthews* is unable to rectify the deficiencies of *Matthews* alone with respect to the current limitation.

For the reasons stated above, claims 2 and 12 are not obvious in view of *Matthews*, *Sutcliffe*, and *Hockey*. The remaining claims depend from these independent claims, recite further limitations, and are therefore allowable in their respective combinations. Favorable action by the Examiner and withdrawal of the cited rejections is respectfully requested. The Examiner is invited to call the undersigned in an effort to discuss and resolve any remaining issues.

Respectfully submitted,

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